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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,030	02/17/2004	Rainer Schneider	5497-67414-01	2830
24197 7590 12/26/2007 KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			EXAMINER LEWIS, RALPH A	
			ART UNIT 3732	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/781,030

Applicant(s)

SCHNEIDER, RAINER

Examiner

Ralph A. Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**Rejections based on 35 U.S.C. 112, first paragraph**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-29, 31-33, 35-37 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In the response of 17 January 2007 applicant amended independent claims 1, 13, 25, 35, 36 and 37 to require a "manual operation to move the adapter leads relative to the supply conduit to match a polarity." The originally filed specification fails to provide support for this limitation. The specification discloses two basic embodiments. In the first embodiment, illustrated in Figures 1, 2, 3A, 3B and 5 applicant discloses an adapter 5 wherein the polarity is switched by disconnecting the adapter from the handpiece 2 rotating it 180 degrees and reinserting it into the handpiece (note page 5, lines 16-27). In this embodiment the adapter leads are manually moved relative to the handpiece, not the supply line as claimed. Rotating the adapter with respect to the supply line 4 would not change the polarity. In the second embodiment, illustrated in Figures 4A and 4B the "movable" adapter leads 16A and 17A somehow move between "position 1" of Fig. 4A and "position 2" of Fig. 4B "via an operating element, preferably a

switch (not shown), in order to produce different lead routings" (description page 5, lines 31-34). This description and accompanying illustrations of the second embodiment do not reasonably enable one of ordinary skill in the art to make or use this embodiment of the invention. It is unclear how a "switch" can simply move the electrical leads 16A and 17A from one side of the adapter to the other. Some sort of undisclosed mechanical arrangement is necessary. Moreover, even if the second embodiment was enabled, adapter leads 16B, 16C, 17B and 17C do not "move relative to the supply conduit" as is required by the present claims.

Additionally, it is noted claim claims 8-12, 20-24, 28 and 29 appear to be directed solely to the second embodiment of Figures 4A and 4B. Applicant does not reasonably disclose the "switch" necessary for moving the leads within the adapter so as to enable one of ordinary skill in the art to practice the claimed invention

#### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6, 14-16, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 requires the adapter leads to be moved with respect to the contacts of the instrument operating element rather than with respect to the supply conduit as is required in parent claim 1. Claim 2 is contradictory to parent claim 1.

Claim 14 requires the adapter leads to be moved with respect to the contacts of the instrument operating element rather than with respect to the supply conduit as is required in parent claim 13. Claim 14 is contradictory to parent claim 13.

Claims 26 and 27 contradict parent claim 25 which requires the switch to be relative to the adapter and supply line, not the adapter and the handle sleeve having a light source.

#### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 13-19, 25-27, 31-33, 35-37 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Bianchetti et al (EP 1103232).

Bianchetti et al disclose in Figure 4 an adapter body 101 having electrical leads 106 that is positioned between a supply conduit 8 and dental light hand piece 103. Electrical power is supplied to the adapter 101 from the supply conduit 8 where it in turn

is supplied to the hand piece 103 by adapter electrodes (leads) 106 disposed diametrically opposite each other (only one visible in Figure 4, column 6, lines 54-57). The hand piece 103 includes first and second electrical contacts 111 and 112 that connect with the adapter electrodes 106 when connected with the hand piece 103. The adapter 101 is symmetrical with electrodes 106 on opposite sides from one another, consequently it is capable of being rotated manually 180 degrees and inserted into hand piece 103 thereby switching the polarity of the adapter electrodes 106 in contact with the handpiece. Moreover, it is noted that the hand piece 103 includes LEDS (column 7, lines 3-7) which inherently and necessarily requires the proper polarity in order to operate.

In regard to claims 1-6 and 31, applicant previously amended claim 1 to require that the manual operation "move the adapter leads relative to the supply conduit," however, as noted above in the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection applicant does not have support for this limitation. Moreover, the "relative to the supply conduit" limitation contradicts dependent claims 2-6 as noted in the 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection above. Accordingly, the "relative to the supply conduit" limitation is herein treated as "relative to the medical instrument."

In regard to claims 13-19, 32 and 39, applicant previously amended claim 13 to require that the manual operation "move the electrical leads of the adapter leads relative to the supply conduit," however, as noted above in the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection applicant does not have support for this limitation. Moreover, the "relative to the supply conduit" limitation contradicts dependent claims 14-16 as noted in the 35

U.S.C. 112, 2nd paragraph rejection above. Accordingly, the “relative to the supply conduit” limitation is herein treated as “relative to the medical instrument.”

In regard to claims 25-27 and 33, applicant previously amended claim 25 to require that the manual operation “move the electrical leads of the adapter leads relative to the supply contacts of the supply conduit,” however, as noted above in the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection applicant does not have support for this limitation. Moreover, the “relative to the supply conduit” limitation contradicts dependent claims 26 and 27 as noted in the 35 U.S.C. 112, 2nd paragraph rejection above. Accordingly, the “relative to the supply conduit” limitation is herein treated as “relative to the medical instrument.”

In regard to claims 35-37, applicant previously amended these claims to require that the manual operation “move the electrical leads of the adapter leads relative to the supply conduit,” however, as noted above in the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection applicant does not have support for this limitation. To the extent that applicant is intending to claim his disclosed first embodiment, then the present rejection applies.

Claims 1, 7, 25, 31, 33, 35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hatley, Jr. (US 6,305,934).

Hatley Jr. discloses in Figure 2 a dental handpiece having an adapter (illustrated with threading) between the handpiece and the supply line (lower portion of Figure 2). The adapter includes electrical leads which could be rotated 180 degrees relative to the supply line and then reinserted into the supply line socket thereby changing the polarity

of the power transmitted to the handpiece. In viewing Figure 3 it is acknowledged that switching the electrical polarity by turning the adapter 180 degrees would also switch the water and air lines. It is noted, however, that merely using a prior art device differently from the manner disclosed fails to make the prior art device patentable.

Claims 1, 8-12 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross (US 4,204,243).

Ross discloses an adapter 10 connectable between a medical instrument (e.g. at 11, 18) and a power supply line/conduit (15, 17). The adapter includes input and output electrical leads that may be switched with switch 26 to reverse the polarity.

Claims 1-6 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Banner (US 3,626,354).

Banner discloses an adapter 1 for connectable between a medical instrument and a power supply line. The adapter includes input and output lines that switch the polarity of the output when rotated 180 degrees.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claims 30, 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianchetti et al (EP 1103232).

Bianchetti et al do not explicitly disclose what happens if a user connects the hand piece 103 to the adapter 101 with the electrical connections inadvertently reversed. One of ordinary skill in the art, however, would have readily understood that when the LEDs are not hooked up with the proper polarity then they will not operate. It naturally follows, then that if the Bianchetti et al device were inadvertently hooked up with the wrong polarities through adapter 101, that one would rotate the adapter 101 with respect to the hand piece 103 to reverse the polarities so that the device would then function.

Claims 13, 17, 20-25, 28, 29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otuska (US 6,638,063) in view of Ross (US 4,204,243)

Otuska discloses in Figure1 a conventional dental light curing device having a plug 4 that is connected to a typical power supply line. Occasionally power supply lines may be wired backwards and it is desirable to provide for an adapter that reverses the polarity of the power supply line in order to protect the equipment to which it is attached as taught by Ross. To have merely used a Ross adapter to reverse the polarity of a power source wired backwards in order to protect the Otuska device and ensure its proper operation would have been obvious to one of ordinary skill in the art.


Claims 13-19, 25-27 and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otuska (US 6,638,063) in view of Banner (US 3,626,354).

Otuska discloses in Figure 1 a conventional dental light curing device having a plug 4 that is connected to a typical power supply line. Occasionally power supply lines may be wired backwards and it is desirable to provide for an adapter that reverses the polarity of the power supply line in order to protect the equipment to which it is attached as taught by Banner. To have merely used a Banner adapter to reverse the polarity of a power source wired backwards in order to protect the Otuska device and ensure its proper operation would have been obvious to one of ordinary skill in the art.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R. Lewis  
December 18, 2007

  
Ralph A. Lewis  
Primary Examiner  
AU 3732